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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PARK, CHAN S

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/387,513	Applicant(s) TOYODA, KIYOSHI	
	Examiner CHAN S. PARK	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-19, 21 and 24-26 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 13, 14, 16-19, 21 and 24-26 is/are rejected.
 7) ☒ Claim(s) 15 is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/3/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 3/15/05, and has been entered and made of record. Currently, **claims 13-19, 21 and 24-26** are pending.

Response to Arguments

2. Upon review of the reference of Zuili (U.S. Patent No. 6,145,084), which was cited in the Office Action dated 12/15/04 under 35 U.S.C. § 102(e), as anticipating claims 25 and 26, the examiner notes that the reference can still be interpreted as anticipating the claims, as *currently amended*.

Particularly, as amended, claims now require "the transmitting Internet facsimile device apparatus being a same type device as the receiving Internet facsimile apparatus". Before discussing the cited reference, the examiner notes that the term "same type device" can be interpreted in many different ways according to current claim wording. For example, if a facsimile data can be transmitted and received between two devices over a network, e.g., the Internet, they can be concluded as the same type devices. Further, if both can print or scan an image data, they can be concluded as the same type devices.

Now, referring to the examiner's cited reference, Zuili clearly teaches that both transmitting and receiving devices are facsimile devices communicating over the Internet network (col. 10, lines 23-26). Since both facsimile devices are (1) facsimile

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devices and (2) communicating over the same network, they are said to be the same type devices, that is, Internet facsimile devices.

In response to the applicant's argument, the applicant states that Zuili's exchange information is related to compatibility for a communication between dissimilar devices whereas the applicant's invention exchanges capabilities including one of a resolution, a paper size, a compression format, and an encryption format that are used for a facsimile communication, between the same type devices. As previously cited by the examiner, Zuili teaches the method for exchanging the capabilities including the encryption scheme that is used between two facsimile devices having different encryption software (col. 5, lines 29-67 & col. 2, lines 25-26).

Further, in response to applicant's argument, wherein pages 11-12, the applicant states that "the pending claims do not require information as to the types of messages, since the pending claims relate to a facsimile communication and thus a type of message utilized for the pending claims is always facsimile data." Again, it is respectfully noted that Zuili explicitly and specifically teaches that the devices can be facsimile devices. Thus, when the facsimile devices are used in the communication, the type of message utilized for the communication is facsimile data (col. 4, lines 46-49).

Further, it is noted that the transmitting device A of Zuili performs the "translation" which is a conversion, based on the encryption scheme of the receiving device, is further required to ensure the effective communication between the devices (col. 5, lines 29-67 & col. 2, lines 25-26).

Therefore, the rejection of claims 25 and 26, as cited in the Office action dated 12/15/04, under 35 U.S.C. § 102(e), as being anticipated by Zuili, is maintained and repeated in this Office Action.

3. Applicant's arguments with respect to claims 13-19, 21 and 24 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

4. Claim 26 is objected to because of the following informalities:

Line 3, "the Internet transmitting Internet facsimile apparatus" should be -- the transmitting Internet facsimile apparatus --;

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 25 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Zuili.

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5. With respect to claim 25, Zuili teaches a capability exchanging method for controlling a transmitting Internet facsimile apparatus (device (A) 14) connected to a receiving Internet facsimile apparatus (device (B) 16) via the Internet, the transmitting Internet facsimile apparatus being a same type device as the receiving Internet facsimile apparatus, the transmitting Internet facsimile apparatus being connected with a first server apparatus (verifying server 12) via a LAN (network between the device (a) and the verifying server 12) and with a second server apparatus (other Web sites servers in col. 6, lines 8-19) via the Internet, at least one of the first server apparatus and the second server apparatus storing capabilities regarding facsimile data that the receiving Internet facsimile (device (B) in col. 4, line 8 and col. 10, line 25) apparatus is capable of receiving (col. 5, lines 12-61), the capability exchanging method comprising:

accessing the first server apparatus (col. 5, lines 12-27);

determining whether or not the first server stores the capabilities regarding facsimile data that the receiving Internet facsimile apparatus is capable of receiving (col. 5, lines 12-27), the capabilities including one of a resolution, a paper size, a compression format, and an encryption format that are utilized for a facsimile communication between the transmitting Internet facsimile apparatus and the receiving Internet facsimile apparatus (col. 5, lines 29-67 & col. 2, lines 25-26);

obtaining, from the second server apparatus, capabilities regarding facsimile data that the receiving Internet facsimile apparatus is capable of receiving, when the first server apparatus is determined not to store the capabilities regarding facsimile data that the receiving Internet facsimile apparatus is capable of receiving (col. 6, lines 5-19);

storing, in the first server apparatus, the capabilities regarding facsimile data that the receiving facsimile is capable of receiving, the capabilities being obtained from the second server (col. 6, lines 5-19).

Examiner read the network between the device (a) and the verifying server 12 as a LAN since Zuili is improving the image communication apparatus in a LAN (col. 2, lines 10-12 & col. 4, line 64 – col. 5, line 2).

6. With respect to claim 26, Zuili discloses a transmitting Internet facsimile apparatus connected with a receiving Internet facsimile apparatus (device (B) in col. 4, line 8 and col. 10, line 25) via a server apparatus on the Internet, the transmitting Internet facsimile apparatus being a same type device as the receiving Internet facsimile apparatus the transmitting Internet facsimile apparatus comprising:

a communicator configured to communicate with a first server apparatus and with a second server apparatus via the Internet (fig. 1 and col. 6, lines 8-19);

a controller that, when the first server apparatus is determined not to store the capabilities regarding facsimile data that the receiving Internet facsimile apparatus can receive, is configured to obtain, from the second server apparatus, the capabilities regarding facsimile data that the receiving Internet facsimile apparatus can receive and to store, in the first server apparatus, the obtained capabilities regarding facsimile data that the receiving Internet facsimile apparatus can receive (col. 6, lines 5-19), the capabilities including one of a resolution, a paper size, a compression format, and an encryption format that are utilized for a facsimile communication between the

transmitting Internet facsimile apparatus and the receiving Internet facsimile apparatus (col. 5, lines 29-67 & col. 2, lines 25-26).

Also, arguments analogous to those presented for claim 25, are applicable.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-14, 16-19, 21 and 24 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Zuili.

7. With respect to claim 13, Zuili discloses a transmitting Internet facsimile apparatus connected with a receiving Internet facsimile apparatus (device (B) in col. 4, line 8 and col. 10, line 25) via a server apparatus on the Internet, the transmitting Internet facsimile apparatus being a same type device as the receiving Internet facsimile apparatus the transmitting Internet facsimile apparatus comprising:

a communicator configured to communicate with a first server apparatus and with a second server apparatus via the Internet (fig. 1 and col. 6, lines 8-19); and

a controller configured to access the first server apparatus to obtain capabilities regarding facsimile data that the receiving Internet facsimile apparatus can receive (col. 5, lines 12-27), the capabilities including one of a resolution, a paper size, a compression format, and an encryption format that are utilized for a facsimile

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communication between the transmitting Internet facsimile apparatus and the receiving Internet facsimile apparatus (col. 5, lines 29-67 & col. 2, lines 25-26),

the controller being further configured, when the first server apparatus is determined not to store the capabilities regarding facsimile data that the receiving Internet facsimile apparatus can receive, to obtain, from the second server apparatus, the capabilities regarding facsimile data that the receiving Internet facsimile apparatus can receive, and to transform image data, based on the obtained capabilities regarding facsimile data that the receiving Internet facsimile apparatus can receive (col. 5, lines 24-61 & col. 6, lines 5-19).

Also, arguments analogous to those presented for claim 25, are applicable.

Zuili does not disclose explicitly that controller converts the transformed image data into data for Internet transmission and transmits the converted data to the receiving facsimile.

Zuili, however, clearly teaches a facsimile communication over the Internet (col. 4, lines 46-49 & col. 6, lines 8-19). Therefore, it would have been inherent/obvious to one of ordinary skill in the art to convert the original image into data for the Internet transmission. The facsimile Internet transmission would be impossible without such the conversion.

Therefore, Zuili teaches the invention as specified in claim 13.

8. With respect to claim 14, Zuili further discloses that the first server apparatus is a local server apparatus in a local area network containing the image communication

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apparatus, and the second server apparatus is a global server apparatus in a global area network connected with the local area network (col. 6, lines 10-13).

Also, arguments analogous to those presented for claim 25, are applicable.

9. With respect to claim 16, Zuili discloses a server apparatus connected with a transmitting Internet facsimile apparatus and a receiving Internet facsimile apparatus via the Internet, the server apparatus comprising;

a memory configured to store capabilities regarding facsimile data that the receiving Internet facsimile apparatus can receive (col. 5, lines 21-28).

With respect to rest of claim, arguments analogous to those presented for claim 13, are applicable.

10. With respect to claim 17, arguments analogous to those presented for claims 13 and 25, are applicable.

11. With respect to claim 18, arguments analogous to those presented for claims 13 and 25, are applicable.

12. With respect to claim 19, refer to col. 6, lines 8-19 of Zuili.

13. With respect to claim 21, Zuili further discloses the image communication apparatus, wherein the receiving facsimile is determined by the image communication apparatus (col. 5, lines 12-14).

14. With respect to claim 24, Zuili further teaches the method of storing, in the first server apparatus, the capabilities regarding facsimile data that the receiving facsimile is capable of receiving, the capabilities being obtained from the second server (col. 6, lines 8-19).

Allowable Subject Matter

15. Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chan S. Park
Examiner
Art Unit 2622

csp
June 14, 2005


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